

Applicants: Robertson, et al.
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REMARKS

Claims 21-26 were pending before this response. By the present communication, claim 26 has been amended to define Applicants' invention with greater particularity. The amendment adds no new matter being fully supported by the Specification and original claims. Applicants submit that the claim amendments do not narrow the claims in any way within the meaning of Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd., a/k/a SMC Corporation and SMC Pneumatics, Inc. 234 F.3d 558, 51 U.S.P.Q. 2d 1959 (Fed. Cir. 2000). Accordingly claims 21-26 are currently pending in this response. It is respectfully submitted that the proposed amendment submitted herewith would place the claims in condition for allowance or at least in better condition for appeal; accordingly, entry of the amendment is respectfully requested.

The Rejection under 35 U.S.C. § 112, second Paragraph

Claim 26 is rejected under 35 U.S.C. §112, Second Paragraph, for allegedly being indefinite in the recitation of "medium to stringent conditions." As Applicant has argued in the Response filed herein on September 10, 2001, the Specification provides support for the phrase "medium to stringent conditions" at pages 9-10. However, to reduce the issues and expedite prosecution, claim 26 has been amended by the present communication to recite that the probe "hybridizes to a nucleic acid comprising a nucleotide sequence having at least 95% identity to SEQ ID NO:23". The new claim language is supported by the Specification wherein it is stated that the term "stringent conditions" means hybridization will occur only if there is at least 95% identity between the sequences (Specification, page 13, lines 7-9). In view of the amendment to

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claim 26, reconsideration and withdrawal of the rejection of claim 26 under 35 U.S.C. § 112, Second Paragraph, are respectfully requested.

The Rejection under 35 U.S.C. §102(a) or (b)

Claim 26 is rejected under 35 U.S.C. §102(a) or (b) as allegedly being anticipated by GenBank Accession No. X86487 or Kim et al. The Examiner asserts that because bases 21-39 of the sequence of GenBank Accession No. X86487 are 100% identical to bases 360-378 of SEQ ID NO:23 and bases 5051-5069 of the gene disclosed by Kim et al are 100% identical to bases 505-523 of SEQ ID NO:23, "each of these fragments would unquestionably specifically hybridize to SEQ ID NO:23. However, Applicant submits that neither GenBank Accession No. X86487 nor Kim et al. disclose an oligonucleotide probe that would hybridize with a nucleic acid comprising a sequence having at least 95% identity to SEQ ID NO:23 or a sequence fully complementary thereto "to form a detectable target probe duplex," as required by claim 26, because neither reference discloses an oligonucleotide probe, as distinguished from a polynucleotide, and neither reference discloses an oligonucleotide probe that is "detectable." Hence, Applicant respectfully submits that each of the cited references fails to disclose each and every element of claim 26 as would be required to support a rejection under 35 U.S.C. § 102 (a) or (b).

Accordingly, reconsideration and withdrawal of the rejection of claim 26 under 35 U.S.C. § 102 (a) or (b), are respectfully requested.

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Conclusion

The Office Action indicates that claims 21-25 are allowable. In view of the above amendments and remarks, passage of claims 21-26 to allowance is respectfully requested. If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' representative, Lisa A. Haile, J.D., Ph.D., can be reached at (858) 677-1456.

Respectfully submitted,

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Enclosure: Exhibit A

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EXHIBIT A

Version with Markings to Show Changes Made

Please amend claim 26 as follows:

26. (Twice Amended) An oligonucleotide probe comprising a sequence which specifically hybridizes [under medium to reduced stringency conditions] to a nucleic acid comprising a nucleotide sequence having at least 95% identity to SEQ ID NO:23 or a sequence fully complementary thereto to form a detectable target probe duplex.